

International Harmonization of Substantive Patent Law (SPLH)

An Overview on the Recent History and Institutional Framework

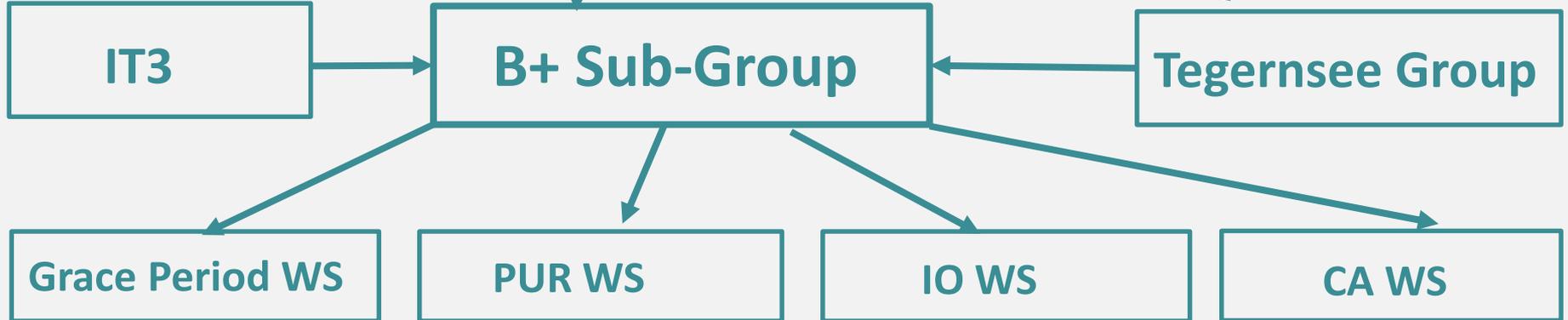
Alexander Pfister, IGE

Head of Legal Service Industrial Property Rights

International Harmonization of Substantive Patent Law
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WIPO's Group B

Group B+



The Group B+

- Created in 2005
- Goals of the Group B+: promote and facilitate progress on key issues under consideration at the World Intellectual Property Organization (WIPO), in particular on SPLH
- Composition of the Group B+:
 - all members of WIPO's Group B (= industrialised countries),
 - EU member states,
 - the European Commission,
 - EPO member states (if not already members of the Group B),
 - the EPO,
 - South Korea.

The Tegernsee Group

2011: a subset of Group B+ members (the “Tegernsee Group”) launched a dialogue on SPLH.

2012: the Tegernsee Group carried out fact-finding studies on **four key harmonisation** issues:

- the grace period
- 18-month publication
- conflicting application
- prior user rights

Over ¾ of users surveyed across major patenting jurisdictions saw harmonisation of these 4 areas **as critical or important**

The Group B+ Sub-Group on Patent Harmonisation

2014: The Group B+ created a **sub-group of Group B+** members to promote progress on SPLH.

Composition :

- Canada
- Denmark
- European Patent Office (EPO)
- Germany
- Hungary
- Japan
- South Korea
- Spain
- US

The four workstreams

2015: Creation of four **Workstreams** (WS) to conduct work on the four Tegernsee issues

- Grace Period: EPO (Chair), AU, CA, **CH**, DE, DK, ES, EU, FR, HU, JP, KR, SE, US.
- Prior User Rights: JP (Chair), AU, **CH**, DE, EPO, FR, KR, SE, US.
- Options for implementation: HU (Chair), BE, CA, **CH**, DE, EPO, JP, KR, SE, US.
- Conflicting applications: US (Chair), CA, EPO, JP, KR, SE, UK.

Industrial Trialateral (IT3)

- Formed in 2013
- Basis for **industry stake holders** in the jurisdictions of the Trilateral Offices:
 - the European Patent Office
 - the Japan Patent Office
 - the US Patent and Trademark Office
- IT3 includes:
 - American Intellectual Property Law Association (AIPPLA)
 - BusinessEurope (BE)
 - Intellectual Property Owners Association (IPO)
 - Japan Intellectual Property Association (JIPA)

The road so far (1/3)

2015 – 2016 : Fact finding and discussions within the WS

May 2016 : Reports of the four WS

Meeting of Sub-Group in London

Sept. 2016: Plenary Meeting Group B+; sub-group circulated a consultation document

The road so far (2/3)

- Feb. 2017:** Information to Swiss interested groups and consultation of Swiss users
- June 2017:** Meeting of Sub-Group with Industrial Trialateral (IT3) in Munich
- Oct. 2017:** Plenary meeting Group B+; Sub-Group circulated a position paper
- Dec. 2017:** Information to Swiss interested groups
- April 2018:** Meeting of Sub-Group with IT3 cancelled

The road so far (3/3)

- Oct. 2019:** Little to no progress of the IT3 on SPLH. Group B+ decide to no longer limit its activity to the IT3 project.
- Sept. 2020:** Little to no progress of the IT3. Within Group B+, conflicting views: other work or pause in the process.
- Mai 2021:** Special Plenary Meeting: refusal of a sub-group on SPLH. Blockage.
- Oct. 2021:** Plenary Meeting: IT3 lifts embargo on Element paper. Group B+ decided to conduct a year of consultation and reflexion.

2022

- **March 2022:** Drafting and approval of the Common Consultation Document.
- **May 2022:** End of the Consultation
- **Sept. 2022:** Plenary Meeting: Presentation and discussion of the national consultation's results.
Future works?

Current situation

- **Group B+**: Gridlocked; SPLH appears only conceivable with the introduction of a grace period.
- **IT3**: No unambiguous proposal – difficult for a package approach (“nothing is agreed until everything is agreed”). BusinessEurope not capable to find a common European line.
- **EPO**: Disagreement – mirrors situation within BusinessEurope.
- **Swiss interest groups**: A grace period would bring judicial insecurity; only as a *safety net* and with a maximum of transparency.

Way forward (2022)

- Limited substantive progress since October 2017.
- The IT3 has been completely deaf to requests for transparency, information and simplification.
- Group B+ in a deadlock.
- Common Consultation Document for Europe.
- Plenary Meeting in September 2022: what to expect?



IGE | IPI

Conclusion



Direct contact:

Felix Addor / Phone +41 31 377 72 01 / felix.addor@ipi.ch

Alexander Pfister / Phone +41 31 377 74 88 / alexander.pfister@ipi.ch

Anaïc Cordoba / Phone +41 31 377 72 54 / anaic.cordoba@ipi.ch